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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,089

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Erin Hall Sibley

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EXAMINER

RABOVIANSKI, JIVKA A

ART UNIT

PAPER NUMBER

2426

MAIL DATE

DELIVERY MODE

08/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/700,089

Applicant(s)

SIBLEY ET AL.

Examiner

JIVKA RABOVIANSKI

Art Unit

2426

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 6 and 8 - 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 6 and 8 - 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/08)
Paper No(s)/Mail Date 01/12/2004, 10/27/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/03/2009 has been entered.

Status of Claims

Claims 1 – 6 and 8 - 16 are pending

Claims 1 and 9 have been amended.

Claim 7 has been canceled.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d

937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 9 rejected on the ground of nonstatutory double patenting over claims 1 and 13 of U. S. Patent of application No. 10/409875 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: *receiving the broadcast encoded programming carried in the vertical blanking and VBI demodulator provides VBI technology that separates the unused portion of the television signal to extract encoded proprietary television programming.*

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant

application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, the limitations “tuning hardware configured to ... to pass the encoded video programming in the vertical blanking interval” and “vertical blanking interval software configured to: ... (2) decode the encoded video programming from the vertical blanking interval” in claim 1 do not have a support in the specification. Claim 16 cites the limitations “the software comprises subscriber management, conditional access, and encryption functions *to control access to the video*

programming in the vertical blanking interval and unused Active lines." was not described in the specification. Specification discloses "the software may also contain forward error correction (FEC) as well as subscriber management, conditional access, and encryption functions:" in [0061] which does not provide the same function as claimed in claim 16.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 – 3, 5, 6, 9 – 11 and 13 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisbergh, Harold M. (US 20040078824 A1, referred to as Krisbergh), and further in view of Yoshimura; Yoshimasa (US 5917467 A, referred to as Yoshimura).

Regarding claims 1, 9 and 16:

A method for providing broadcast video programming, comprising:

(a) receiving video programming (Krisbergh teaches: Fig. 4 - the cable headend equipment; [0029]);

(b) encoding the video programming into a vertical blanking interval and unused Active lines of a television channel (Krisbergh teaches: the television transmission may alternatively include one or more *streams of data comprising video*, audio and other information in a digital and/or analog form. Accordingly, information can be inserted into these streams such as in the VBI as aforesaid or as part of an MPEG transport stream [0027]; Fig. 4/46);

(c) broadcasting the television channel and encoded video programming into a vertical blanking interval and unused Active lines of a television signal (Fig. 4/12)

(d) receiving the broadcast encoded video programming in a vertical blanking interval in a user device, wherein the user device comprises (Krisbergh teaches: Fig.6/terminal 54):

(i) a mobile portable handheld device; Krisbergh does not specifically disclose a portable device. However, Yoshimura discloses PC card contains RF antenna terminal for inputting an RF signal from an external antenna for receiving a TV broadcast where the PC card system can receive a TV broadcast by a *portable PC* to display images on the LCD panel col. 11 lines 4 – 44, Fig. 4.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krisbergh with the teaching of portable device for receiving a broadcast signal as further taught in Yoshimura to meet all limitation in claim 1.

(ii) tuning hardware configured to receive normal over-the-air terrestrial broadcasts and to pass the encoded video programming in a vertical blanking interval (Krisbergh teaches: Fig. 6/94; television distribution systems and networks include but are not limited to orbiting satellite systems, terrestrial wireless cable systems [0024]);

(iii) vertical blanking interval software configured to:

(1) receive output from the tuning hardware (Krisbergh teaches: Fig.6/94,92); and

(2) decode the encoded video programming from the vertical blanking interval (Krisbergh teaches: Fig. 6/98);

(IV) a screen and a speaker (Krisbergh teaches: Fig. 6/56; [0050]; and

(v) decompression software configured to:

(1) decompress the decoded video programming (Krisbergh teaches: processor 96 for decoding and decompressing the coded and/or compressed refresh information [0049]); and

(2) output analog audio and video signals from the decoded video programming to enable a user to watch the video programming on the screen and speaker of the user device (Krisbergh teaches: television signal is displayed on the display device – Fig. 6/56; the MPEG 2 data stream is composed of video, audio streams [0046]).

Regarding claims 2 and 10:

The method of claim 1, wherein the unused Active lines comprise Active lines that are hidden above and below typical lines that a viewer can see on a normal television screen. It is well known that the vertical blanking interval is the time interval between the end of the last line of one frame or field of a raster display, and the beginning of the next. During the VBI the incoming data stream is not displayed on the screen (unused Active lines). In analog television systems the vertical blanking interval can be used to carry digital data, since nothing sent during the VBI is displayed on the screen.

Regarding claims 3 and 11:

The method of claim 1, wherein the encoded video programming is completely transparent to the television channel that is broadcast (Krisbergh teaches: The encoded broadcast video signal (Fig. 6) is applied to a video blanking interval decoder that decodes the encoded broadcast video and the encoded video signal can be watch on the TV screen).

Regarding claims 5 and 13:

The method of claim 1, further comprising receiving the broadcast encoded video programming in a wireless device (Krisbergh teaches: television distribution systems and networks include orbiting satellite systems, terrestrial wireless cable systems – [0024]).

Regarding claims 6 and 14:

The method of claim 5, wherein the wireless device comprises a receiver card for receiving the broadcast encoded video programming.

Krisbergh teaches a receiver for receiving broadcast programs. Krisbergh fails to teach a plug-in card for receiving encoded video program. However, Yoshimura discloses PC card contains RF antenna terminal for inputting an RF signal from an external antenna for receiving a TV broadcast where the PC card system can receive a

TV broadcast by a *portable PC* to display images on the LCD panel
col. 11 lines 4 – 44, Fig. 4.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krisbergh with the teaching of portable device for receiving a broadcast signal as further taught in Yoshimura to meet all limitation in claim 6.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krisbergh, and further in view of James, Randy (James hereinafter) US 20020019987 A1.

Regarding claim 8;

The method of claim 7, wherein the vertical blanking interval software further comprises subscriber management, conditional access, and encryption functions to control access to the video programming in the vertical blanking interval and unused Active lines.

Krisbergh discloses vertical blanking interval decoder, but fails to specify other functions. However, James discloses that the VBI receiver module is specifically designed for quick response VBI-ID/Message identification and subscriber communications processing – see include, but not limited to [0026].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krisbergh with the teaching of subscriber communication processing as further taught in James to meet all limitation in claim 8, in order to protect transmitted information from unattended access.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisbergh, in view of Corvin, Johnny B. (Corvin hereinafter) US 20010029610 A1.

Regarding claims 4 and 12:

Krisbergh teaches a receiver for receiving broadcast programs. Krisbergh fails to disclose the encoded video programming comprises a promotional cable channel. However, Corvin discloses that a program may be received on a program channel and a promotion may be received through this program channel's vertical blanking interval (VBI) – see [0024].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krisbergh with the teaching of video programming comprises promotional channel as further taught in Corvin to meet all limitation in claim 4, in order to supply users with more information.

Examination Considerations

8. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d, 1393, 1404-05, 162 USPQ 541,550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.
9. Examiner's Notes are provided with the cited references to prior art to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior

art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

10. Unless otherwise annotated, Examiner's statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent prima facie statement.

11. Examiner's Opinion: paragraphs 8 - 10 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Contact

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jivka Rabovianski whose telephone number is (571) 270-1845. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH HIRL can be reached on (571) 272-3685. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jivka Rabovianski/

August 12, 2009

/Joseph P. Hirl/

Supervisory Patent Examiner, Art Unit 2426

August 14, 2009